REMARKS

Claims 1-20 remain pending in this application. New claim 20 has been added in this amendment and accompanying RCE. No new matter has been introduced. Favorable reconsideration is respectfully requested.

Claims 1-8 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Hagting* (WO 97/15160) in view of *Ward* (US Patent 5,974,320). Claims 9 and 11-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. The Applicants respectfully traverse the rejections. Favorable reconsideration is respectfully requested.

The Applicants wish to reiterate the arguments put forth in the Response of July 7, 2003, and further wish to clarify the Applicants position regarding the cited art. Specifically, *Hagting* does not disclose "first messages having first information are at least temporarily sent at least from one part of the first [synchronous] base stations, said first information indicating that the first base stations are surrounded by at least one of the second [asynchronous] base stations" as recited in claim 1. The Examiner has acknowledged this deficiency in the Office Action dated October 23, 2003 (page 2, paragraph 2, lines 11-13).

However, *Ward* does not solve the deficiency of *Hagting*, discussed above. Specifically, *Ward* discloses a MAHO system wherein base stations transmit the same neighborhood list to a mobile switching center (MSC), which specify the measurement channels being utilized within a neighborhood zone (col. 4, lines 16-20). As was stated previously, the neighborhood list disclosed in *Ward* does not indicate whether a "first base stations are surrounded by at least one of the second base stations." Instead, the neighborhood list **transmits the measurement channels, which are shared and reused by more than one base station,** and are dependent on the mobile terminal used (see col. 4, lines 24-40; col. 5, lines 9-24; col. 6, lines 37-46). Thus, the system in *Ward* will not know to distinguish among base stations like that claimed in the present application. The passages cited by the Examiner (col. 6, lines 2-36 and col. 8, lines 28-50) do not state anything to the contrary. In fact, col. 8, lines 28-50 is completely silent regarding the use of synchronous and asynchronous base stations, and only instructs "mobile stations traveling

within each of said plurality of first base stations to measure said indicated measurement channels for mobile service." This clearly does not teach the claimed invention.

Secondly, claim 1 recites the first base stations as being synchronous, and the second bases stations as being asynchronous (illustrated above in brackets for claim 1). *Ward* is silent regarding the base stations communicating whether synchronous base stations are surrounded by asynchronous bases stations.

Furthermore, the teaching in *Hagting* makes it improper to combine with the teaching in *Ward* to arrive at the obviousness conclusion stated by the Examiner. While the Examiner properly acknowledged that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, there also must be a *teaching, suggestion or motivation* to do so (see MPEP 2141). In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983) (MPEP 2141.02). And the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP 2143.01).

Notwithstanding the fact that *Ward* did not teach the aforementioned limitation, there is no reason to modify the teaching in *Hagting* in this regard, since *Hagting* teaches that the radio communication unit establishes a "global air usage map" that includes synchronously and asynchronously operating radio links (page 6, lines 20-24). The system scans the radio environment to obtain synchronous and asynchronous radio access links, maintains a list of these links and evaluates the list on the basis of predetermined radio link criteria to determine whether handover or roaming has to be initiated (page 6, lines 6-18). Thus, since *Hagting* already maintains a global list of stations, there is no teaching, motivation or suggestion (other than to improperly glean knowledge from the Applicants' disclosure) to modify the reference to transmit "first messages having first information are at least temporarily sent at least from one part of the first base stations, said first information indicating that the first base stations are surrounded by at least one of the second base stations."

While not binding on the Examiner, the aforementioned rationale was also maintained by the Examiner in the International Preliminary Examination Report, a copy of which is enclosed herein in support of this Response.

Also, the Examiner recited that one motivation to incorporate such a combination would be "to improve the battery life of the mobile unit for only receiving a message that includes the surrounding base stations." However, this is simply incorrect, since the teaching in *Hagting* relies on a global list, which does not rely on further messaging from the base stations. By transmitting a "first message having first information" from each participating base station in *Hagting*, the end result would be an increase in power consumption, and hence, a decrease in the battery life of the mobile unit. Accordingly, the motivation stated in the Office Action is in incorrect and should be withdrawn.

For at least these reasons, the Applicants submit that the rejection under 35 U.S.C. §103 is improper and should be withdrawn. An early Notice of Allowance is earnestly requested.

A petition for a two-month extension of time has been submitted with this response, along with a check in the amount of $420. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (0112710-0506) on the account statement.

Respectfully submitted,

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